

Docket 83194F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Dale F. McIntyre, et al

ALBUM LEAF WITH INSERT

Serial No. 09/973,031

Filed 09 October 2001

Group Art Unit: 3722
Confirmation No.: 5074
Examiner: Mark T. Henderson

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Commissioner for Patents
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Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1 and 3-33, which was contained in the Office Action mailed January 30, 2007.

A timely Notice of Appeal was filed April 10, 2007.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1,3-12, 32 and 33 are pending in the application.

Claim 33 is objected to.

Claims 1, 3-12 and 32 stand rejected and are being appealed

Claim 2 has been cancelled and claims 13-31 have been withdrawn.

Appendix I provides a clean, double-spaced copy of the claims on appeal.

Status Of Amendments

All amendments have been entered and the claims stand as indicated in Appendix I.

Summary of Claimed Subject Matter

The invention according to claim 1 is directed to an image product assembly 10, comprising:

a dual sided album leaf 12 (see Fig. 1) having a first ply layer 14 and a second ply layer 16, said first and second ply layers 14, 16 each having an outer surface and an inner surface, said first and second ply layers 14, 16 are secured together so as to form a pocket 23 there between, said outer surface of

said first and/or second ply layer having a plurality of images 30, 32 (see Fig.2A) formed thereon; and

an insert 24 having a size and configuration such that it can be placed within said pocket 23, said insert 23 having information 41, 43 thereon that relates to said plurality of images 30, 32, said information on said insert is located in a position on said insert 24 such that it can be readily identified with respect to which of said plurality of images 30, 32 it is associated (see Fig. 2A). Fig. 2B also illustrated the relation of the information on the insert 24 with respect to images on the album leaf and Fig. 2B show the same images as Fig. 2a wherein a different mechanism is used to identify the information with it's associated image.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1, 3 and 12 are unpatentable under 35 U.S.C. 102(b) over Bromer et al (5,445,417).
2. Whether claims 1, 4 and 12 are unpatentable under 35 U.S.C. 102(b) over Liener Chin et al (6,632,042).
3. Whether claim 4 is unpatentable under 35 U.S.C. 103(a) over Liener Chin et al (6,632,042).
4. Whether claims 5 and 6 are unpatentable under 35 U.S.C. 103(a) over Bromer et al in view of Fountain.
5. Whether claim 7 is unpatentable under 35 U.S.C. 103(a) over Bromer et al in view of Young.
6. Whether claims 8-11 are unpatentable under 35 U.S.C. 103(a) over Bromer et al in view of Hawley.
7. Whether claim 32 is unpatentable under 35 U.S.C. 103(a) over Bromer et al.

Arguments

Neither Bromer et al. or Liener Chin et al. teach or suggest the invention of claim 1.

Applicant respectfully submits that the Bromer et al and the Liener Chin et al references do not disclose or teach the invention as claimed by claim 1 (the only independent claim in the present application) nor are they even relevant to the claimed invention. In particular, independent claim 1 is directed to an image product assembly that includes a dual cited album leaf, which comprises the first and second ply layers that are secured together to form a pocket, wherein the outer surface of the first and second ply layers having a plurality of images formed thereon. In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "'usually . . . dispositive. . . [and] the single best guide to the meaning of a disputed term.'" Id. (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582). With regard to what is an album leaf, Applicant respectfully submits that an album leaf as claimed requires providing a plurality of images thereon. As set forth in Webster's New Collegiate Dictionary, an album is defined as "a book or binder with blank pages for mounting a collection, as of stamps or photographs therein." Further, as set forth in the specification, at page 5, lines 22-25, sets forth that in the preferred embodiment the media forming the album leaf having images formed on the emulsion side of the media (e.g. photographic paper). Thus, an album leaf made according to the present invention has images formed integrally thereon and are images that are not meant to be seen through. Since there are images on both the front and backside of the album leaf, it would be nonsensical that the images could be viewed through the ply layers as disclosed in the cited art, as then one image would interfere with the other. Thus, it is clear that the first and second ply layers of the present invention are such that distinct images can be viewed on either side. This is in complete contrast to the Bromer et al and Liener Chin et al references. As set forth in the Bromer et al reference, this reference is directed to a presentation folder and method of making, which includes a plastic cover sheet and a back cover sheet that may be joined at a

common edge. There is no teaching or suggestion for providing images on the front and back cover of the type to which the present invention is directed. Quite the contrary, what is disclosed in Bromer et al. is a sheet having pre-applied graphics forming selected opaque display areas and the remaining areas being transparent or translucent that is capable of revealing at least one of the information on the papers provided therein. Thus, it is clear that Bromer et al is not directed to ply layers having images formed thereon, as taught and claimed by Applicant.

In addition, the present invention is directed to providing an insert in conjunction with the album leaf so that it can be placed within the pocket formed by the dual-sided album leaf; wherein, information is provided on the insert that relates to the plurality of images and is located in a position on the insert such that it can be readily identified with respect to which of the plurality of images it is associated. It is respectfully submitted that the letters provided on the sheet placed in the folder of Bromer et al does not provide any information with regard to the images on the outside. As previously discussed, there are no images as taught and claimed by Applicant. Furthermore, there is no teaching or suggestion in this reference of providing information relating to the images. Nor, does the reference teach or suggest that these are located in a position such that the information can be associated with the appropriate image. Applicant respectfully submits that the Examiner has misinterpreted the cited prior art.

The Liener Chin et al reference suffers from many of the same problems that the Bromer et al suffers with regard to the present invention. As set forth at Column 7, lines 66 through page 8, line 5, of Liener Chin et al, this reference therein is directed to transparent front and back sheets 308 and 312. Since these are transparent sheets, it does not provide the plurality of images on an image product as taught and claimed by Applicant. It is respectfully submitted that the Liener Chin et al is deficient for the same reasons discussed with Bromer et al.

The Fountain, Young and Hawley references were cited against various dependent claims, all of depend at least ultimately upon independent claim 1. These additional cited references all fail to teach or suggest the invention as set

forth in independent claim 1 and are therefore patentable for the same reasons previously discussed.

The Examiner in rejecting claim 32 states:

“It has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from prior art in terms of patentability. . . . The examiner asserts that the Brome et al. reference comprises an insert in the context of printed material. Thus, there is no novel and obvious functional relationship the printed matter (printed image) and the substrate (insert) which is required for patentability. Accordingly, there being no functional relationship of the printed matter to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which by itself, is non-statutory subject matter.”

As applicant have previously pointed out the printed matter does indeed have a function relationship with respect to images on the substrate. In fact the Board of Patent Appeals and Interferences acknowledged this functional relationship in a prior appeal in this instant application. The Board stated:

“The examiner argues that there is no functional relationship between appellant’s printed matter and the substrate (answer, p. 6). The functional relationship is that the printed matter must be located in a position on the insert such that it can be readily identified with respect to which of a plurality of images on the outer surface of a ply layer the information is associated.”

For the examiner to argue there is no functional relation goes against what has already been decided by the Board of Patent Appeals and Interferences in the instant application. Applicant respectfully submits that there is indeed a functional relation as set forth by the claims.

Summary

For the reasons discussed above it is respectfully submitted that the cited prior fails to anticipate or render obvious, either singly or combined, the invention as claimed.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims.

Respectfully submitted,



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Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Appendix I - Claims on Appeal

1. (Previously Presented) An image product assembly, comprising:
 - a dual sided album leaf having a first ply layer and a second ply layer, said first and second ply layers each having an outer surface and an inner surface, said first and second ply layers are secured together so as to form a pocket there between, said outer surface of said first and/or second ply layer having a plurality of images formed thereon; and
 - an insert having a size and configuration such that it can be placed within said pocket, said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated.
3. An image product assembly according to claim 2, wherein said information is correlated with respect to its associated image by providing a size of said associated image at a reduced size having reduced visual characteristics.
4. An image product assembly according to claim 1, wherein said outer surface of said first ply layer and second ply layer each have a plurality of images and said insert having information with respect to said images on said first and second surfaces, said information being provided on said insert.

5. An image product assembly according to claim 1, wherein said insert is provided with a retaining member that prevents the insert from being pulled completely out of said pocket.

6. An image product assembly according to claim 5, wherein said retaining member comprises a pair of restraining tabs disposed at opposite ends of said insert, the restraining tabs being designed to be stopped by a retaining section in said leaf.

7. An image product assembly according to claim 1 wherein insert is folded such that when it is placed within said pocket it causes said insert to be retained within said pocket.

8. An image product assembly according to claim 1, wherein said first and second ply layers each comprise four sides and said first and second ply layers are secured together along three of said four sides.

9. An image product assembly according to claim 8, wherein an adhesive is used to secure said first and second ply layers together.

10. An image product assembly according to claim 8, wherein a generally u-shaped member is positioned along three of said four sides is provided for securing said first and second ply layers together.

11. An image product assembly according to claim 10, wherein an adhesive is applied to the inner surface of said first and second ply layers.

12. An image product assembly according to claim 1, wherein said first and second ply layers are formed by folding a single sheet.

32. An image product assembly according to claim 1 wherein said information is correlated with respect to associated image by providing an outline copy of set associated image on said insert.

33. An image product assembly according to claim 1 wherein said insert includes a low resolution or intensity image copy of the original image provided on said first ply layer or second ply layer.

Appendix II - Evidence

None

Appendix III – Related Proceedings

A prior decision by the Board of Patent Appeals and Inferences in the instant application was mailed on May 30, 2006, Appeal No 2006-1498, Application 09/973,031.